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OFFICE OF PETITIONS

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|-----------------------------------|---|-------------|
| In re Application of | : | |
| Pan et al. | : | |
| Application No. 09/682685 | : | ON PETITION |
| Filing or 371(c) Date: 10/05/2001 | : | |
| Title of Invention: | : | |
| EFFICIENT MULTI-SLICE | : | |
| ACQUISITION WITH BLACK BLOOD | : | |
| CONTRAST IN FAST SPIN ECHO | : | |
| IMAGING | : | |

This is a decision on the "Petition Under 37 C.F.R. § 1.183 Requesting Waiver of Requirements of 37 C.F.R. § 1.48(a) and Declaration in Support Thereof, filed November 29, 2006. The petition is properly treated as a request for waiver of 37 CFR 1.48(a)(2), which requires a statement from each person being added and from each person being deleted as an inventor that the error occurred without deceptive intention on his or her part.

The petition is dismissed.

Petitioner is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under [insert the applicable code section]"; should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

Petition to correct inventorship

Applicant files with the present petition for waiver, a rule 48 petition to correct inventorship by adding inventors Thomas K.F. Foo and Zahi A. Fayad, and deleting inventors Tin-Su Pan, Steven J. Woloschek and H. David He. The rule 48 petition includes a statement from each person being added that the error occurred without deceptive intention on his or her part. A statement from deleted inventor Woloschek is also provided, that the error occurred without deceptive intention on his part. A statement from inventors Pan and He has not been provided.

The present petition under 37 CFR 1.183

Petitioner files the present petition requesting waiver of 37 CFR 1.48(a)(2), that requires a statement from each person being added and from each person being deleted as an inventor that the error occurred without deceptive intention on his or her part.

In support of the petition, Applicant states that he attempted to contact inventors Pan and Hu via telephone, but was unsuccessful. Applicant also states that he attempted to contact inventor Tan via email, but that too was unsuccessful. Further efforts of the Applicant to contact inventors Pan and He include email correspondence from Applicant to the Assignee requesting information as to the whereabouts of the inventors.

Applicable Law, Rules and MPEP

Under 37 CFR 1.48(a), if the correct inventor or inventors are not named in an executed oath or declaration under 37 CFR 1.63 in a nonprovisional application for patent, the application can be amended to name only the actual inventor or inventors so long as the error in the naming of the inventor or inventors occurred without any deceptive intention on the part of the person named as an inventor in error or the person who through error was not named as an inventor.

37 CFR 1.48(a) requires that the amendment be accompanied by:

- (1) a request to correct the inventorship that sets forth the desired inventorship change;
- (2) a statement from each person being added and from each person being deleted as an inventor that the error occurred without deceptive intention on his or her part;
- (3) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47;
- (4) the fee set forth in 37 CFR 1.17 (i); and
- (5) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

The MPEP further provides that:

[i]n those situations where an inventor to be added refuses to submit a statement supporting the addition or such party cannot be reached, waiver under 37 CFR 1.183 of the requirement for a statement from that party would be appropriate upon a showing of such refusal or inability to reach the inventor. Every existing assignee of the original named inventors must give its consent to the requested correction. Where there is more

than one assignee giving its consent, the extent of that interest (percentage) should be shown. Where no assignment has been executed by the inventors, or if deletion of a refusing inventor is requested, waiver will not be granted absent unequivocal support for the correction sought. Petitions under 37 CFR 1.47 are not applicable to the requirement for statements from each originally named inventor. (Emphasis supplied).

MPEP 201.03

Regarding a showing of refusal or inability to reach the inventor, Applicant is advised that, where an inventor is unavailable (cannot be reached), Petitioner must establish the exercise of diligent effort in trying to find or reach the nonsigning inventor. A statement of facts should be submitted from a person with first hand knowledge of the facts relied upon that fully describes the exact facts which are relied on to establish that a diligent effort was made to locate the inventor. *See*, MPEP § 409.03(d).

Here, Applicant provides copies of email between Applicant and the assignee. However, Applicant has failed to establish the exercise of diligent effort in trying to find or reach the nonsigning inventor. At the very least, an Internet search, or a search of telephone directories should be undertaken of the regions where it is suspected the inventors may reside. Copies of the results of such searches must be referred to in any renewed petition. It is important that the forthcoming communication contain statements of fact as opposed to conclusions. *See*, MPEP § 409.03(d).

It is also noted that Applicant has indicated that the invention may have been assigned. 37 CFR 1.48(a)(5) requires the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

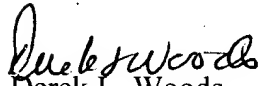
Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

A handwritten signature in black ink, appearing to read "Derek L. Woods".

Derek L. Woods

Attorney

Office of Petitions